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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/674,733	05/02/2001	Michael Szardenings	1085.0050000/RWE	3759

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EXAMINER

CHISM, BILLY D

ART UNIT PAPER NUMBER

1654

DATE MAILED: 10/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/674,733

Applicant(s)

SZARDENINGS ET AL.

Examiner

B. Dell Chism

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-64 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Election/Restrictions

- I. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-24 and 27, drawn to a compound of claimed general formula I, a prodrug and pharmaceutical composition thereof.

Group II, claim(s) 25-26 and 28, drawn to a DNA molecule encoding a compound of general formula I, and a vector comprising said DNA.

Group III, claim(s) 31, drawn to a method of inhibiting formation of nitric oxidized and/or nitrite.

Group IV, claim(s) 32, drawn to for a method of immunomodulation.

Group V, claim(s) 33, drawn to a method of treating contact hypersensitivity.

Group VI, claim(s) 34 and 35, drawn to a method of treating sensitization by a hapten.

Group VII, claim(s) 36, drawn to a method of treating the formation of oedema.

Group VIII, claim(s) 37 and 57, drawn to a method of treating inflammation of blood vessels or vasculitis.

Group IX, claim(s) 38, drawn to a method of normalizing white blood cell counts.

Group X, claim(s) 39, drawn to a method for stimulating cAMP.

Group XI, claim(s) 40-41, 44, drawn to a method of treating a disease or disorder of inflammation or an inflammatory like condition.

Group XII, claim(s) 42, drawn to a method of treating inflammation of the skin.

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Group XIII, claim(s) 43, drawn to a method of treating inflammatory disease in the abdomen.

Group XIV, claim(s) 45, drawn to a method of treating the peripheral and central nervous system related to inflammation.

Group XV, claim(s) 46-47, drawn to a method of treating a disease or condition of the eye and tear glands related to inflammation.

Group XVI, claim(s) 48, drawn to a method of treating the inflammation of the nose.

Group XVII, claim(s) 49, drawn to a method of treating inflammation in the upper alimentary canal.

Group XVIII, claim(s) 50, drawn to a method of treating inflammation in the lung.

Group XIX, claim(s) 51, drawn to a method of treating inflammation related to the heart.

Group XX, claim(s) 52, drawn to a method of treating inflammation in the lungs.

Group XXI, claim(s) 53, drawn to a method of treating inflammation of the pancreas.

Group XXII, claim(s) 54, drawn to a method of treating inflammation of the thyroiditis.

Group XXIII, claim(s) 55, drawn to a method of treating inflammation of the kidney.

Group XXIV, claim(s) 56, drawn to a method of treating inflammation of the joints.

Group XXV, claim(s) 58, drawn to a method of treating arteriosclerosis.

Group XXVI, claim(s) 59, drawn to a method of treating drug-induced disorders of the blood and lymphoid system.

Group XXVII, claim(s) 60, drawn to a method of treating fast allergic disorders (Type I allergy).

Group XXVIII, claim(s) 61, drawn to a method of treating inflammation associated with infectious diseases or conditions.

Group XXIX, claim(s) 62, drawn to a method of treating tissue trauma and tissue injury.

Group XXX, claim(s) 63, drawn to a method for stimulating pigment formation in epidermal cells.

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Group XXXI, claim(s) 64, drawn to a method for inhibiting pigment formation in cells of the skin.

2. Groups XI and XXVIII-XXIX are generic to a plurality of disclosed patentably distinct species comprising those species as claimed within the respective claims of each group. If Applicants elect either of the Groups XI, XXVIII or XXIX, Applicant is required to elect a single disclosed species from that group, even though this requirement is traversed.


3. The inventions listed as Groups I-XXXI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the compounds of the claimed general formula I lack a special technical feature that links all groups under a single general inventive concept. When the Markush grouping is for alternatives of chemical compounds, the shall be regarded as being of similar nature where the following criteria are fulfilled: 1) a common property or activity; and 2) a common structure present... However, as is indicated by Claim 1 of Group I, the compound alternatives have different properties and activities as described in Claim 1 a)-d) of Group I.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to B. Dell Chism whose telephone number is 703-306-5815. The examiner can normally be reached on 7:30 AM - 4:30 PM, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on 703-306-3220. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

B. Dell Chism
30 September 2003


BRENDA BRUMBACK
SUPERVISORY PATENT EXAMINER
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